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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BERMAN, ALYSIA

ARTICLE PAPER NUMBER

DATE MAILED: 01/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/009 453

Examiner

Alysia Berman

Applicant(s)

FABRY ET AL

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s): _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of the amendment filed October 30, 2002. Claim 9 has been amended. Claims 9-20 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 9, 10, 12-16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,939,079 (079).

This rejection is maintained for reasons of record. US '079 is directed to a dispersion of at least one pulverulent organic filler and/or at least one pulverulent inorganic filler (abstract). For metal soaps as the organic filler see column 4, lines 50-58 and claims 16 and 19. US '079 teaches at column 4, lines 56-58 that these metal soaps

generally have a particle size less than 10 microns and facilitate adhesion of the powders to the skin. A particle size less than 10 microns encompasses the instantly claimed mean diameter particle size range.

US '079 does not explicitly teach metal soaps having a mean diameter of about 10 to 300 nm.

It is within the skill in the art to select optimal parameters in a composition in order to achieve a beneficial effect. *In re Boesch*, 205 USPQ 215 (CCPA 198). "It is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Only if the "results optimizing a variable" are "unexpectedly good" can a patent be obtained for the claimed critical range. *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977); see also *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (in banc). Absent evidence of unexpected results, the particle size of the metal soaps is not given patentable weight.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of US '079 using metal soap particles of optimal mean diameter with the reasonable expectation of obtaining a cosmetic composition that adheres to the skin.

Claims 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,939,079 (079) as applied to claims 9, 10, 12-16 and 18-20 above, and further in view of US 2,456,437 (437).

This rejection is maintained for reasons of record. US '079 teaches all the limitations of the claims as stated in the 35 U.S.C. 103(a) rejection above. It does not teach metal soap particles coated with a compound of claims 11 and 17.

US '437 teaches that soap particles coated with an organic material such as starch and gums (col. 2, line 50 to col. 3, line 1) overcome the disadvantages of dusting and agglomeration.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of US '079 using coated metal soaps as taught by US '437 expecting to provide homogeneous metal soap compositions.

Response to Arguments

Applicant's arguments filed October 30, 2002 have been fully considered but they are not persuasive.

Applicant argues that US '079 failed to teach the instantly claimed particle size of metal soaps. The range disclosed by the reference encompasses the instantly claimed particle size range. It is well known in the art that smaller particles size provides more stable compositions. Further, it is not considered inventive to optimize ranges in order to achieve a beneficial effect. *In re Boesch*, 205 USPQ 215 (CCPA 198). One of ordinary skill in the art would reasonably expect that the use of smaller particles in the composition of US '079 would lead to a more stable composition. As stated above, burden is shifted to Applicant to show that the instantly claimed particle size is critical to the invention.

Applicant argues that there is no motivation to apply the organic material of US '437 onto the metal soaps of US '079 since there is no teaching or suggestion to coat inorganic soap particles with the organic materials of US '437. Upon a fair review of US '437, the Examiner could find no disclosure that excluded inorganic soap particles. On the contrary, US '437 discusses the use, advantages and disadvantages of soap particles in general without any limitations. All disclosures in a reference patent must be evaluated, including non-preferred embodiments. A reference is not limited to disclosure of the specific working examples. See *In re Mills* 176 USPQ 196 (CCPA 1972). Disclosure of a composition of matter in a reference may be anticipatory even though the reference indicates that the composition is not preferred or even that it is unsatisfactory for the intended purpose. See *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). One of ordinary skill in the art would have a reasonable expectation of success in coating any type of soap particles with the organic materials of US '437.

Applicant argues that there is not teaching or suggestion that the problem addressed by US '437, dust particles, is experienced with metal soap particles. As discussed above, US '437 is not limited to any particle kind of soap particles and, so does not exclude metal soap particles.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within


TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysia Berman
Patent Examiner
January 18, 2003

